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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,821	12/21/2000	Tim Kerry Keyes	85CF-00111	8655

7590 02/25/2003

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EXAMINER

FELTEN, DANIEL S

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 02/25/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/745,821

Applicant(s)
Keyes

Examiner
Daniel Felten

Art Unit
3624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 12, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 8 6) ☐ Other:

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DETAILED ACTION

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2
3 1. Receipt of the amendment filed December 12, 2002 amending claims 1, 11 and 21 are
4 acknowledged. Claim 1-30 are pending and are presented to be examined upon there merits.
5
6

7 *Claim Rejections - 35 USC § 101*
8

9 2. 35 U.S.C. 101 reads as follows:

10 Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
11 matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
12 conditions and requirements of this title.
13

14 The claimed invention is directed to non-statutory subject matter. The limitations
15 which reside within the body of claims 1-10 and 21-30, are directed to nothing more than
16 abstract ideas which are equivalent to human making mental computations that are not tied to
17 any technological art and not considered a useful art as contemplated by the Constitution.

18 Re claims 1-10: The abstract idea(s) presented in the body of the claims do not
19 become a technological art merely by the recitation of, "....predicting value of non-
20 underwritten assets for which data representations are partial or incomplete...", "underwriting
21 assets...", "forming market value clusters", etc, (see Ex parte bowman, 61, USPQ2d 1669,
22 1671 (Bd. Pat. App & Inter. 2001)).

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1
2 Re claim 21: The abstract idea(s) presented in the body of the claims do not become
3 a technological art merely by the recitation of, "a computer configured of non-underwritten
4 assets..." because the limitation of "a computer" is found only within the preamble of the
5 claim, wherein the technical merit found within the limitations of the body.

6
7
8 ***Claim Rejections - 35 USC § 112***

9 3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

10 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming
11 the subject matter which the applicant regards as his invention.

12
13 4. Claims 11-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite
14 for failing to particularly point out and distinctly claim the subject matter which applicant
15 regards as the invention. The aforementioned claims use the limitation of, "a system...". It is
16 unclear if the claims are referring to an apparatus or a method.

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Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ***Daniel S. Felten*** whose telephone number is (703) 305-0724. The examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday. Any inquiry of a general nature relating to the status of this application or its proceedings should be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor ***Vincent Millin*** whose telephone number is (703) 308-1065.

6. Response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

for formal communications intended for entry, or (703) 305-0040, for informal or draft communications, please label "Proposed" or "Draft".

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to *[daniel.felten@uspto.gov]*.


All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly

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1 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
2 Trademark on February 25, 1997 at 1 195 OG 89.

3
4 
5 DSF

6 February 20, 2003


VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600